

REMARKS

Claims 11-17 are pending in the present Application. Claims 11, 14 and 15 have been amended, leaving claims 11-17 for consideration upon entry of the present Amendment.

It is believed that the amendments made herein may be properly entered at this time, i.e., after final rejection, because the amendments do not require a new search or raise new issues and reduce issues for appeal.

No new matter has been introduced by these amendments. Support for the amendments is found throughout the Specification beginning at least at page 4, paragraph [16] and the claims and drawings, particularly Figure 3, as originally filed. Entry of the Amendment is respectfully requested, since it places the claims in condition for allowance. Reconsideration and allowance of the claims are respectfully requested in view of the above amendments and the following remarks.

Claim Objections

Claims 14 and 15 are objected to because of informalities due to typographical errors. Applicants have amended the claims to correct the informalities and believe the amendments place the claims in condition for allowance.

Therefore, removal of the objections is respectfully requested.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 11-12 and 16-17 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent 5,053,930 to Benavides (“Benavides”) in view of U.S. Patent 4,401,050 to Britt et al. (“Britt”). Claims 13-15 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over Benavides as applied to claim 11, and further in view of Britt. Applicants respectfully traverse these rejections.

Benavides is generally directed to a phosphorescent vehicle part identification accessory including a phosphorescent article or molding. The disclosed phosphorescent articles or moldings include vehicle side moldings, valve stem caps and keyhole protective shields that may be affixed around a keyhole. There is no disclosure or suggestion of a self-illuminating roof assembly as claimed.

Britt discloses an escape route indicator having at least one protruding indicia formed thereon having a phosphorescent material applied to the undersurface of the indicia. (Abstract; col. 6, lines 10-11.) Nothing in Britt that remedies the deficiency in Benavides. Simply put, there is no disclosure or suggestion of a self-illuminating roof assembly.

Applicants’ claimed self-illuminating roof assembly comprises a vehicle roof wall and an interior panel that substantially covers the interior surface of the vehicle roof wall, the interior panel comprising a phosphorescent material and a polymer matrix. These features are not taught or suggested by the combination of references nor would it be obvious to one of skill in the art in view of these references.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a prima facie case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). Establishing a prima facie case of obviousness requires that all elements of the invention be disclosed in the prior art. *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970). Further, even assuming that all elements of an invention are disclosed in the prior art, an Examiner cannot establish obviousness by locating references that describe various aspects of a patent applicant’s invention without also providing evidence of the motivating force which

would have impelled one skilled in the art to do what the patent applicant has done. *Ex parte Levingood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. Int. 1993). The references, when viewed by themselves and not in retrospect, must suggest the invention. *In Re Skoll*, 187 U.S.P.Q. 481 (C.C.P.A. 1975).

A prima facie case of obviousness has not been established because the cited references fail to teach or suggest a self-illuminating roof assembly comprising a vehicle roof wall and an interior panel that substantially covers the interior surface of the vehicle roof wall, the interior panel comprising a phosphorescent material and a polymer matrix.

Applicants have carefully studied and can find nothing in Benevides or Britt, either alone or in combination, that suggests or teaches a self-illuminating roof assembly having an interior panel comprising a phosphorescent material and a polymer matrix .

From the comments provided in the Office Action, it appears the Examiner agrees with this position. However, the Examiner believes that it would have been obvious to one of ordinary skill in the art to use the phosphorescent illuminating devices of Benavides on or near a sunroof for the purpose of increasing safety by providing easily locatable switches (e.g., a sunroof switch) as well as providing pleasure to the occupants. (Final Office Action, dated 3/30/06, p.3, paragraph 4). Applicants respectfully disagree with this conclusion and believe it is contrary to well established patent laws.

Applicants request the Examiner provide support for the presumption that one of skill in the art would find it obvious to modify the cited Benevides and/or Britt in the manner proposed without any explicit teaching or motivation to make the modification. In contrast to the Examiner's logic, those of ordinary skill in the art have already provided a solution to the problem of illuminating switches. Switches for operating the sunroof as well as for most every vehicle function are generally backlit with an LED or some other light source to provide switch illumination at night. The backlighting of the switches generally occurs automatically or upon activation of the external lighting system, e.g., parking lights, headlights. Moreover, occupant actuated interior lights have been employed in vehicles for quite some time.

Obvious to try, which is what the Examiner proposes, is not the legal standard when analyzing claims for *prima facie* obviousness. Obviousness is not based upon what an artisan could do or what an artisan may try, but is based upon what an artisan would be motivated to do with an expectation of success. “Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *In re Kahn*, No. 04-1616 (CAFC March 22, 2006) citing *In re Lee*, 277 F.3d 1338, 1343-46 (Fed. Cir. 2002); and *In re Rouffett*, 149 F.3d 1350, 1355-59 (Fed. Cir. 1998). “When the Board does not explain the motivation, or the suggestion or teaching, that would have led the skilled artisan at the time of the invention to the claimed combination as a whole, [it is] infer[ed] that the Board used hindsight to conclude that the invention was obvious.” *Id.* Additionally, “[a]lthough the suggestion to combine references may flow from the nature of the problem, ‘[d]efining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.’” (internal citation omitted) *Id.*, quoting *Monarch Knitting Mach. Corp. v. Sulzer Morat GmbH*, 139 F.3d 877, 881 (Fed. Cir. 1998); *In re Beattie*, 974 F.2d 1309, 1312 (Fed. Cir. 1992). An Examiner, then, cannot base a determination of obviousness on what the skilled person in the art might try or find obvious to try. Rather, the proper test requires determining what the prior art would have led the skilled person to do. Based on the Examiner’s comments and the content provided in the cited references, it is clear that the Examiner is improperly relying on hindsight.

Second, it appears that the Examiner continues to misunderstand Benavides with respect to its disclosure of a sunroof. In Benavides, the sunroof and/or convertible top is described as conduit for providing light into the interior of the vehicle so as to “charge” the phosphorescent articles disposed therein.

...[a] rear window and a side window through which light from other sources can illuminate the inside of the vehicle. The top of the vehicle will be, in many instance, constructed with a sunroof and/or a convertible top so that light can likewise be cast therein, particularly from overhead streetlights and from the sun during the day. The front windshield is likewise shown behind the hood over which light will be received from on-coming vehicle.

(Benavides, Col. 4, 39-47)

This is not the same as a roof assembly comprising an interior panel formed a phosphorescent material in a polymeric matrix. Still further, the disclosure in Benevides of a “sunroof” as a light conduit does not provide any teaching or suggestion of applying a phosphorescent interior panel that substantially covers the vehicle roof, especially since such a suggestion would be contrary to the function of the sunroof as disclosed by Benevides.

Even if the teachings of Benevides could be modified to arrive at the claimed subject matter, the modification is not obvious unless the prior art also suggests the *desirability* of such a modification. *In re Laskowski*, 10 U.S.P.Q.2d 1397, 1398 (Fed. Cir. 1989). Absent in Benavides is any teaching or suggestion to seek an interior roof assembly which substantially covers the interior surface of the roof wall. At best, Benevides and Britt provide what may be obvious to try, but for reasons discussed above “obvious to try” is not a valid test of patentability. *In re Mercer*, 185 U.S.P.Q. 774 (CCPA 1975). In addition, the purpose of Applicants’ self-illuminating roof assembly is not necessarily to provide light for switch operation but rather to provide ambient light of a magnitude sufficient to permit occupants to view objects within the vehicle yet not be distracting to passing vehicles. This is a commercial advantage over what is currently available in the prior art.

With regard to claims 13-15, it is the Examiner’s position that it would have been obvious to use the phosphorescent material of Britt for the phosphorescent illuminating device of Benevides for the purpose of providing a protection of the phosphorescent material by placing under the polymer layer and enhancing the pleasure of the passengers by providing self-illuminating parts in various shapes. (Office Action dated 3/30/06, p. 6). Once again, the Examiner over-extends the teachings of Benevides and injects an improper obvious to try consideration. Moreover, claims 13-15 are dependent claims and as such include all limitations found in the base claim. For reasons previously discussed, Britt fails to compensate for the deficiencies of Benevides and fails to teach or suggest Applicants’ claimed self-illuminating roof assembly.

In summary, the references fail to teach or suggest a self-illuminating a vehicle roof assembly that substantially covers the interior surface of a roof wall. Applicants respectfully assert that a prima facie case of obviousness has not been established against Claims 11-17 and that the rejections should be withdrawn and the claims allowed.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance are requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 06-1130.

Respectfully submitted,

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